

OCT 30 2006

Docket 84196BTJS
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Loretta E. Allen, et al

IMPROVED LABEL AND
METHOD OF MAKING

Serial No. 10/762,169

Filed 21 January 2004

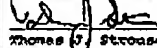
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Commissioner for Patents
P.O. Box 1450
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Group Art Unit: 2876

Confirmation No. 3766

Examiner: Kimberly D. Nguyen

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Thomas J. Strouse

October 30, 2006
Date

Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

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APPELLANT'S BRIEF ON APPEAL

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1 and 2 which was contained in the Office Action mailed May 31, 2006.

A timely Notice of Appeal was filed July 25, 2006.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1 and 2 are pending in the application.

Appendix I provides a clean, double spaced copy of the claims 1-2 on appeal.

Status Of Amendments

Preliminary Amendment mailed February 6, 2004.

Initial Office Action mailed June 23, 2005.

Amendment mailed September 23, 2005.

Office Action mailed December 1, 2005.

Amendment mailed March 1, 2006.

Final Office Action mailed May 31, 2006.

Notice of Appeal mailed July 25, 2006.

Summary of Claimed Subject Matter

With respect to claim 1, Appellant's invention relates to a method of providing a machine-readable indicia on a media having a protective overlayer 14. See page 6, lines 26-30. More particularly, the claim requires providing a first machine-readable indicia 32 in an image layer 26 on said media 28. See page 17,

line 9 – page 18, line 2 and Fig. 9. The invention further requires providing a second machine-readable indicia 34 in a protective overlayer 14 that is identical in content to, and in register with said first machine-readable indicia 32 in said image layer 26. Accordingly, the invention requires identical machine-readable indicia in an image layer 26 and in a protective overlayer 14. The reflective characteristics of the protective overlayer 14 are altered in the area of the second machine-readable indicia 34, which is in register with first machine-readable indicia 32. The reflective characteristics of first machine-readable indicia 32 are such that light is absorbed in printed areas and reflected in non-printed area. By changing the reflective characteristics of the second machine-readable indicia 34 in the protective overlayer 14 in register with the reflective characteristics of first machine-readable indicia 32, the readability of the indicia on label 30 is enhanced when read with, for example, an incident-beam laser scanner. See page 17, line 9 – page 18, line 16 and Fig. 9.

With respect to claim 2, Appellant's invention relates to a method of providing indicia on a media having a protective overlayer 14. See page 6, lines 26-30. More particularly, the claim requires providing a first machine-readable indicia 32 in an image layer 26 on said media 28. See page 17, line 9 – page 18, line 2 and Fig. 9. The invention further requires providing a second machine-readable indicia 34 in a protective overlayer 14 that is identical in content to, and in register with said first machine-readable indicia 32 in said image layer 26. Accordingly, the invention requires identical machine-readable indicia in an image layer 26 and in a protective overlayer 14. The reflective characteristics of the protective overlayer 14 are altered in the area of the second machine-readable indicia 34, which is in register with first machine-readable indicia 32. The reflective characteristics of first machine-readable indicia 32 are such that light is absorbed in printed areas and reflected in non-printed area. By changing the reflective characteristics of the second machine-readable indicia 34 in the protective overlayer 14 in register with the reflective characteristics of first machine-readable indicia 32, the readability of the indicia on label 30 is enhanced when read with, for example, an incident-beam laser scanner. See page 17, line 9 – page 18, line 16 and Fig. 9.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether the invention of claims 1 and 2 is anticipated under 35 U.S.C. 102(e) by Soscia (US 6,636,332).

Arguments**REJECTIONS UNDER 35 U.S.C. 102(e) OVER SOSCIA (US 6,636,332)****CLAIMS 1-2**

CLAIMS 1-2 ARE NOT ANTICIPATED UNDER 35 U.S.C. §102(e) BY SOSCIA (US 6,636,332) BECAUSE SOSCIA FAILS TO SHOW ALL OF THE ELEMENTS RECITED IN CLAIMS 1-2.

- a. **SOSCIA DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, AT LEAST PROVIDING A SECOND MACHINE-READABLE INDICIA IN A PROTECTIVE OVERLAYER THAT IS IDENTICAL IN CONTENT TO, AND IN REGISTER WITH SAID FIRST MACHINE-READABLE INDICIA IN AN IMAGE LAYER AS REQUIRED BY INDEPENDENT CLAIMS 1 AND 2.**

Soscia fails to teach or suggest at least providing a second machine-readable indicia in a protective overlay that is identical in content to, and in register with said first machine-readable indicia in said image layer as required by Appellant's independent claims 1 and 2. In order to render a claim anticipated by the prior art, each and every element of the claim must be disclosed in a single reference. In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303,1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "usually . . .dispositive. . . [and] the single best guide to the meaning of a disputed term." *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit

confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317. Accordingly, Appellant respectfully disagrees with the Office Actions assertion that Soscia's "indicia 40 is . . . in register with the first indicia 20." See paragraph 6 on page 3 of the final Office Action. Appellant submits that register is defined as "to correspond exactly." WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY, 992 (1990).

Soscia merely discloses the generation of indicia 40, which is an image data file that represents an image 20 and is in the form of a two-dimensional encoded compressed variable array. See Col. 7, lines 17-20; Figs. 2, 3 and 6. Also, it is clear from Figs 2, 3 and 6 that the two-dimensional array 40 of Soscia is not identical in content to, and in register with the asserted first machine-readable indicia in an image layer 20. See page 17, line 29 – page 18, line 16 and Fig. 9 of Appellant's Specification. Moreover, the sectional view of Fig. 4 of Soscia also illustrates how the two-dimensional array (indicia 40) is not identical in content to, in register with the image layer 70/80/90 of image 20. Col. 5, lines 45-51.

b. SOSCIA DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, AT LEAST PROVIDING MACHINE-READABLE INDICIA IN A PROTECTIVE OVERLAYER AS REQUIRED BY INDEPENDENT CLAIMS 1 AND 2.

Second, Soscia does not disclose providing machine-readable indicia in a protective overlayer. Rather, Soscia discloses that the image 20 includes first, second and third colorant layers 70/80/90, a fourth layer 100 (i.e., fourth color plane) including an indicia 40 overlaying the third colorant layer 90, and a fifth clear protective layer 110 for protecting the fourth layer 100 (including indicia 40) from damage. See Col. 4, lines 20-41; Fig. 4; Col. 5, lines 45-51. Accordingly, the indicia 40 of Soscia is not in a protective layer. Thus, Soscia does not disclose, expressly or inherently, providing a machine-readable indicia in a protective overlayer.

- c. **SOSCIA DOES NOT DISCLOSE, EXPRESSLY OR INHERENTLY, AT LEAST PROVIDING A FIRST MACHINE-READABLE INDICIA IN AN IMAGE LAYER ON A MEDIA AS REQUIRED BY INDEPENDENT CLAIMS 1 AND 2.**

Soscia fails to teach or suggest at least providing a first machine-readable indicia in an image layer on said media. Rather, Soscia discloses an image 20 includes first, second and third colorant layers 70/80/90. Soscia discloses that the image 20 and indicia 40 are printed a recording medium and that indicia 40 can be optically scanned. *See* Col. 5, lines 45-57. However, Soscia does not disclose, expressly or inherently, providing a first machine-readable indicia in an image layer.

d. **CONCLUSION**

Accordingly, Soscia does not teach, expressly or inherently, the above limitations. Therefore, Appellant respectfully submits that claims 1 and 2 are patentable over the cited reference.

Summary

For the above reasons, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1 and 2.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Deposit Account No. 05-0225.

Respectfully submitted,



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Enclosures

Attorney for Appellant
Registration No. 53,950

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

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Appendix I - Claims on Appeal

1. A method of providing a machine-readable indicia on a media having a protective overlayer comprising the steps of:
 - a) providing a first machine-readable indicia in an image layer on said media; and
 - b) providing a second machine-readable indicia in a protective overlayer that is identical in content to, and in register with said first machine-readable indicia in said image layer.

2. A method of providing indicia on a media having a protective overlayer comprising the steps of:
 - a) providing a first machine-readable indicia in an image layer on said media; and
 - b) providing a second machine-readable indicia in a protective overlayer that is identical in content to, and in register with said first machine-readable indicia in said image layer.

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Appendix II - Evidence

None

Appendix III – Related Proceedings

None

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343 STATE STREET
ROCHESTER, NEW YORK 14650-2201**

DATE: 30 October 2006

TO: EXAMINER: Kimberly D. Nguyen FAX NO. 571-273-8300
GROUP 2876
U.S. PATENT OFFICE

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RE: U.S. Serial No. 10/762,169
Filed January 21, 2004
Inventor(s): Loretta E. Allen et al.
Docket No.: 84196BTJS

Attached is Applicant's Appeal Brief

Total Pages Including Cover Sheet 13

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October 30, 2006

Date

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA. 22313-1450

Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

Attorney for Appellants
Registration No. 53,950

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Respectfully submitted,

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